

Claim 1 calls for an an image transfer device that includes a reader and a display exclusively used by the image transfer device for displaying an image transfer menu, and a computer removably connected to the image transfer device.

When the image transfer device is not connected to the computer, the image transfer device has a first type of the image transfer menu available for display on the display included on the device, and when the image transfer device is connected to the computer the transfer device has a second type of the image transfer menu available for display on the display included on the device.

Cotte et al. discloses a paper input device 214, for example, a scanner, that shares a serial port on a computer 210 with another device. Upon insertion of a document into scanner 214, a menu 250 appears on a display of computer 210, presenting options for processing the scanned image. The scanner 214 does not include any display.

Applicants respectfully submit that Cotte et al. fails to disclose an image transfer device that includes a display that is used exclusively by the image transfer device. Cotte et al. also fails to disclose a first type of image transfer menu available for display on the display-included on the device when the image transfer device is not connected to the computer. Additionally, Cotte et al. fails to disclose a second type of the image transfer menu available for display on the display included on the device when the image transfer device is connected to the computer.

The display disclosed in Cotte et al. is a display on computer 210 and not a display included on an image transfer device. The

scanner 214 in Cotte et al. clearly includes no display and shares the display on the computer 210. Figures 10 and 12 show a scanner 214 connected to a host computer 100 and a drop down menu 250 on the display of host computer 110. The scanner plainly includes no display of its own but uses the display of host computer 110. The display on host computer 110 is used for any application that may be running and is not exclusive to scanner 214.

The Final Office Action states that "In order to overcome Cotte's teaching, applicant should clarify that the display 24 is included in the transfer means 12 and not the display of the computer 14."

Indeed, Applicants' claim 1 clearly recites:

"... the image transfer device including ... a display exclusively used by the image transfer device for displaying an image transfer menu for effecting transfer of the image; and

a computer removably connected to the image transfer device;"

Thus, claim 1 clearly distinguishes that the display is part of the image transfer device and is not the display of the computer.

Further, Applicants respectfully note that merely because the input device 214 in Cotte et al. causes an interrupt which vectors processing by computer 210, does not mean that the display is used exclusively by the input device for displaying an image transfer menu. As shown in figure 12, the drop down menu occupies only a small portion of the screen and may appear

over a background showing icons, other menus, processes, tasks, etc. present on the display.

Cotte et al. fails to disclose that the image transfer device has a first and second type of image transfer menu available for display on the image transfer device, depending on whether the image transfer device is connected to the computer.

The Final Office Action correctly points out that Cotte et al. has no disclosure related to whether the image transfer device is connected or not connected to the computer. However, the Final Office Action goes on to state that it would have been obvious to consider that Cotte et al. teaches two different display menus in two different cases whether the computer is connected or not, since the displayed menu in Figure 17 is different from the display menu of the computer.

Claim 1 however, does not call merely for two different display menus, but rather for first and second types of image transfer menus. In Cotte et al., when the scanner is disconnected from the computer, there is no image transfer menu of any kind on the display. X

It would not be obvious to one looking at Cotte et al. to consider implementing a first and second menu depending on whether a computer is connected because it would be impossible for scanner 214 to display anything if computer 210 were disconnected, let alone a first or second type of menu.

At least for these reasons Applicants respectfully submit that claim 1 is patentable over Cotte et al.

Claims 1-13 depend from claim 1 and therefore are also patentable over Cotte et al.

Regarding claim 2, Cotte et al. fails to disclose that the input device is anything but a scanner. Figures 10 and 11A, referred to by the Final Office Action, show a host computer having a serial port," ...coupled to an input device using scanning technology (hereafter paper input device) 114 (Column 8, lines 17-19). In figure 11A, also referred to by the Office Action, "... one embodiment of the input device paper input device 114 electronics and their connections to the host and Fax modem are shown" (column 8, lines 32-34).

With reference to claim 3, Cotte et al. fails to disclose or suggest that the image transfer device includes a memory for storing the first type of the image transfer menu, and also fails to disclose a user interface for accessing one of the types of image transfer menu displayed on the display. While the scanner, or paper input device 114, is disclosed as having a memory 132 in Figure 11A, the memory does not store a type of image transfer menu, in particular, an image transfer menu for display on the image transfer device. All menus are generated by software resident on computer 210, there is no disclosure related to any menus being stored in the memory of the scanner.

The scanner in Cotte et al. has no user interface for accessing an image transfer menu. The Office Action equates item 134 in Figure 11A with such a user interface. Item 134 is a UART, that is, a universal asynchronous receiver transmitter, that connects to the host computer 110. As such, Cotte et al. has no disclosure related to the UART as acting as a user interface for accessing an image transfer menu.

With regard to claim 4, there is no disclosure in Cotte et al. related to storing menus in the memory of the scanner. Furthermore, the scanner has no display apart from the computer,

and no processor programmed to display a menu on a display of the scanner. In addition, Cotte et al. fails to disclose that the computer has software enabling the processor of the scanner to display a menu on the scanner.

Concerning claim 5, there is no disclosure in Cotte et al. of an image transfer menu for display on the scanner and no disclosure of storing such a menu on the computer.

Regarding claim 6, there is no disclosure in Cotte et al. of sending a portion of a menu from the computer to the scanner.

With reference to claims 7 and 8, as mentioned above, Cotte et al. does not disclose or suggest a first or second menu for display on the scanner.

With regard to claim 9, as mentioned above there is no disclosure in Cotte et al. that the paper input device is anything other than a scanner.

Concerning claim 10, Applicants find no disclosure in Cotte et al. disclosing the second type of menu, and no disclosure related to collating copies, or adding a logo, a message, page numbering, or a watermark.

Claim 14 is directed to a transfer apparatus having a reader and a controller. The transfer apparatus includes a connector for removably connecting a computer and a display connected to the controller for displaying menus comprising features for operating the transfer apparatus. The display displays a first one of the menus when the computer is not connected to the apparatus, and the display displays a second one of the menus when the computer is connected to the apparatus, the second menu

comprising extended features for operating the apparatus in comparison to the first menu.

There is no display on Cotte et al.'s scanner and no provision to display a particular menu depending on whether a computer is connected. The Final Office Action correctly points out that Cotte et al. fails to disclose limitations related to whether the image transfer device is connected or not connected to the computer. Furthermore, Applicants respectfully point out that connecting or disconnecting the computer in Cotte et al. does not cause different menu displays.

In addition Cotte et al. does not display a first menu comprising features for operating the transfer apparatus when the computer is not connected. Because the scanner has no display, it would be impossible to display anything if the computer were disconnected. The "regular menu" displayed by Cotte et al. is not a menu for operating the transfer apparatus. Cotte et al. also fails to disclose a second menu comprising extended features for operating the apparatus in comparison to the first menu.

Claims 15-18 depend from claim 14 and are also patentable over Cotte et al.

In particular, claim 15 includes features similar to claim 3, claim 16 has features similar to claim 6, claim 17 has features similar to claim 4, and claim 18 includes features similar to claims 7 and 8. The arguments supporting claims 15-18 are the same as claims 3, 6, 4, and 7 and 8, respectively.

Claim 19 is directed to a method for transferring information from a first medium including providing an image transfer device

having a scanner and reading an image on the first medium with the scanner.

Significantly, the method includes automatically uploading electronic data to the transfer device from a computer, automatically merging the electronic data with the image read by the scanner by a processor of the image transfer device, and transferring the merged image by the transfer device to a second medium.

A careful reading of Cotte et al. finds no disclosure related to an image device processor merging data from a computer with an image read by the scanner. In addition, there is no disclosure related to transferring such a merged image to a second medium.

Claim 20, by virtue of its dependency, is patentable over Cotte et al.

Claim 21 is directed to a method for enhancing operating features of a transfer device including providing a first command menu stored in a memory of the transfer device, representing a first set of the operating features of the device, and available for display on a display of the device. The method also includes connecting a computer to the transfer device, and with the computer, enabling the device to display a second command menu when the computer is connected to the device. The second command menu represents a second set of the operating features of the device, which has expanded operating features in comparison to the first set of operating features.

Cotte et al. is not related in any way to enhancing operating features of a transfer device. Cotte et al. fails to disclose a first command menu available for display on a display of the device. There is no disclosure in Cotte et al. related to the

device having a command menu stored in memory. There is also no disclosure in Cotte et al. related to a command menu representing a first set of operating features, and no disclosure related to the device having a display. Cotte et al. also fails to disclose enabling the device to disclose a second menu with the computer when the computer is connected, and fails to disclose that the second menu represents a second set of expanded features.

Claims 22-26 depend from claim 21 and are method claims that recite features similar to those of claims 2-13. Because of their dependency and for the same reasons argued in support of claim 2-13, they are patentable over Cotte et al.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

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Respectfully submitted,

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